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Paper No. 9

JAMES E. PARSONS  
SKJERVEN MORRILL MACPHERSON LLP  
25 METRO DRIVE, SUITE 700  
SAN JOSE, CA 95110-1349

**COPY MAILED**

**DEC 18 2001**

**OFFICE OF PETITIONS**

In re Application of :  
Seo, Chung, Paek, Ku & Yee :  
Application No. 09/816,852 : DECISION REFUSING STATUS  
Filed: 23 March, 2001 : UNDER 37 CFR 1.47(a)  
Attorney Docket No. AB-1128 US :

This is in response to the petition filed under 37 CFR 1.47(a) on  
29 August, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of  
this decision to reply, correcting the below-noted deficiencies.  
Any reply should be entitled "Request for Reconsideration of  
Petition Under 37 CFR 1.47(a)," and should only address the  
deficiencies noted below, except that the reply may include an  
oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**

Extensions of time may be obtained in accordance with 37 CFR  
1.136(a).

The above-identified application was filed on 23 March, 2001,  
with a declaration naming Seong Min Seo, Young Suk Chung, Jong  
Sik Paek, Jae Hun Ku, and Jae Hak Yee as joint inventors and  
signed by joint inventors Seo, Chung, and Paek on behalf of  
themselves and joint inventors Ku and Yee. Petitioners assert  
that Ku and Yee have refused to sign the declaration for the  
application.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1). In regards to item (1), petitioners have not submitted sufficient evidence to prove that a copy of the application was sent or given to the non-signing inventors. Petitioners have shown that a letter was sent to counsel for ST Assembly Test Service, Ltd. (STATS), which petitioners state they believe is the current employer of Ku and Yee, asking for Ku and Yee to review the application and sign the declaration. There is no showing, however, that Ku and Yee were ever given the opportunity to review the application papers. Petitioners must show proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) were sent or given to the non-signing inventor for review.<sup>1</sup>

Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventors at their last known addresses (or that of the inventors' attorneys) or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Petitioners must also present proof that the non-signing inventors refuse to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Further correspondence with respect to this matter should be addressed as follows:

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<sup>1</sup>MPEP 409.03(d).

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood  
Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy